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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/883,790	06/18/2001	Matthew Vacek	1470.001US1	2513

7590 05/01/2003

SCHWEGMAN, LUNDBERG, WOESSNER & KLUTH, P.A.  
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EXAMINER

GRAHAM, MARK S

ART UNIT	PAPER NUMBER
3711	

DATE MAILED: 05/01/2003

9

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K

<b>Office Action Summary</b>	<b>Applicant No.</b>	<b>Applicant(s)</b>	
	09/883,790	VACEK ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Mark S. Graham	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

- 1) Responsive to communication(s) filed on 25 February 2003.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

- 4) Claim(s) 1-3 and 5-16 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-3 and 5-8 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-3 and 5-16 are subject to restriction and/or election requirement.

#### **Application Papers**

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
 If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### **Priority under 35 U.S.C. §§ 119 and 120**

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
 a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### **Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

Claims 5-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 5-8 are dependent on a cancelled claim leaving the intent of the claims unclear.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, and 6 are rejected under 35 U.S.C. 102(b) as being anticipated by Uke. In response to applicant's amendments and arguments Uke at Col. 4, lines 11-14 specifically states that the handle may be made of nylon while the barrel is formed of "softer ABS/nylon alloy." These are "different" resins as required by applicant's claims even though one constituent of the resin is common to both. Uke makes clear that various different resins may be used and that the barrel is to be made of a tougher though softer material. Uke also clearly advises the use of different fibers in the handle and barrel throughout his disclosure.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3, 5, 7 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uke.

Concerning claim 3, Uke discloses that the stiffness of the layers may be varied as desired. It would have been obvious to one of ordinary skill in the art to have varied the stiffness within the range claimed by applicant if such a stiffness was desired by a particular batter.

Regarding claims 5 and 8, Uke discloses that the bat layers may be constructed in various fashions as desired. Both tubular socks and sheet materials are commonly known methods of applying fiber reinforced composite layers and would obviously have been suitable for the ordinarily skilled artisan looking to construct Uke's bat depending on what material was more readily available or cheaper.

With regard to claim 7, E-glass is commonly known and would have been suitable for use as Uke's fiberglass.

In response to applicant's arguments over the 35 U.S.C. 103(a) rejection it is first noted that the claim 8 rejection has not been contested. Therefore applicant has implicitly acknowledged the propriety of this rejection.

Regarding the rejection of claims 3, 5, and 7 Uke discloses the use of different resins and fibers in the barrel and handle as explained above. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958

F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one of ordinary skill in the art would lead one to use less stiff fibers if a more flexible bat was desired and stiffer fibers if a stiffer bat was desired given Uke's teaching that the fiber type may be varied as desired to obtain different stiffness values in the barrel and handle as desired. (See Col. 4, lines 18-22). Applicant's further suggestion that Uke teaches the non-use of fibers in the barrel when they are used in the handle is simply without merit. Uke specifically discloses the use of fibers in both sections at the same time. Note for example Col. 4, lines 14-19.

As to the "3 times " limitation of claim 3, the examiner considers it well within the realm of one of ordinary skill in the art to have stiffened the handle 3 times as much as the barrel if that was the feel desired by the batter. Uke specifically teaches that the materials should be varied to the desires of the feel requested by the batter.

Regarding the claim 7 argument, the applicant has not contested the fact that E-glass fibers are commonly known. Uke clearly teaches that other known fibers may be used as desired.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

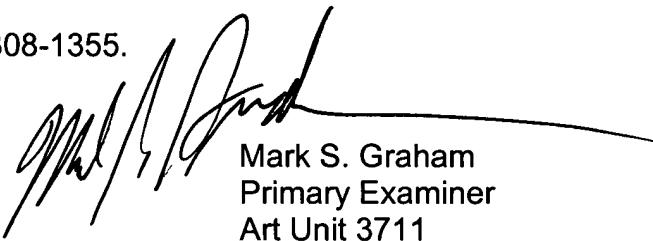
Application/Control Number: 09/883,790  
Art Unit: 3711

Page 5

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication should be directed to Mark S. Graham at telephone number 703-308-1355.

MSG  
4/22/03



Mark S. Graham  
Primary Examiner  
Art Unit 3711